

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1875.0710001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

Filed

10/046,724

January 17, 2002

First Named Inventor

Dolors SALA

Art Unit

Examiner

2616

Park, Jung H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 54,463

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Michael D. Specht

Typed or printed name

(202) 371-2600

Telephone number

October 12, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SALA *et al.*

Appl. No.: 10/046,724

Filed: January 17, 2002

For: **System and Method for a Generalized
Packet Header Suppression Mechanism**

Confirmation No.: 2556

Art Unit: 2616

Examiner: Park, Jung H.

Atty. Docket: 1875.0710001

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Remarks, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Remarks

Applicants respectfully request that the Panel reopen prosecution on the merits and issue a Notice of Allowance of the claims that were filed in the Amendment and Reply under 37 C.F.R. 1.116 on September 12, 2007 ("Sept. 12th Amendment"). The amendments to the claims filed in the Sept 12th Amendment added no new matter. The amendments simply placed the claims in better form and incorporated subject matter already deemed allowable by the Examiner into two independent claims, such that those claims and their dependent claims would also be allowable. The Examiner has agreed that the claims are allowable, but has refused to enter the amendments. See attached Interview Summary. The Examiner suggested that the Applicants file an RCE. Ordinarily, the Applicants would have overlooked the PTO procedural errors, as discussed below, and simply filed an RCE as the most expedient way to have the claims allowed and secure a patent. However, in light of the PTOs new RCE rules, this option is no longer

feasible. Herewith, Applicants are including a Petition to withdraw the finality of the Office Action, dated April 12, 2007. As discussed below, Applicants are confident that such a petition will be successful. Nonetheless, Applicants believe the most cost effective way to resolve the issues discussed below is for the Panel to reopen prosecution and issue a Notice of Allowance. Upon receipt of a Notice of Allowance, Applicants will withdraw their petition of the finality of the Office Action, dated April 12, 2007, and their Appeal.

The Applicants request is based on the following rational: (i) the claims presented in the Sept. 12th amendment are allowable, as already informally indicated by the Examiner, (ii) the failure of the Examiner to withdraw the finality of the Office Action dated April 12, 2007 denied Applicants the opportunity to place the application in condition for allowance, (iii) the failure of the Examiner to enter the after final amendments that did not raise new issues requiring further considerations and/or search denied the Applicants another opportunity to place the application in condition for allowance, (iv) the failure of the Examiner's SPE to allow the Examiner to issue a Notice of Allowance after the interview of October 10, 2007, unnecessarily prolonged the prosecution of this application, and (v) reopening prosecution and instructing the Examiner to issue a Notice of Allowance is the most effective and appropriate way to resolve the prosecution of this case.

First, Applicants acknowledge that they are aware that the refusal to enter an amendment, 37 CFR §1.127, and the premature nature of a final rejection, MPEP § 711.03 (c), are petitionable decisions and are not requests that are appropriate for this Panel to review. The Applicants are not requesting that the Panel make a determination as to the Finality of the Office Action dated April 12, 2007 or the failure of the Examiner to enter the amendments filed in the Sept. 12th Amendment. Applicants simply request that the Panel reopen prosecution and enter the Sept 12th Amendments, thereby placing the application in condition for allowance, and

rendering the petitionable issues moot. Upon entry of the amendments, there is no actual issue for appeal. This request is within the scope of appropriate actions under a Panel Decision. See New Pre-Appeal Brief Conference Pilot Program, OG Notices: 12 July 2005, Format of Panel Decision, Finding 2.

Proposed Amendments

In the Office Action dated April 12, 2007 the Examiner indicated that claims 24-30 describing a descriptor table were allowable. The Proposed Amendments, also referred to herein as the Sept. 12th Amendments, amended claim 24-30 to place claims 24-30 in better form, and amended the descriptor table element in both claim 1 and 12 to include allowed elements from claim 24. The Proposed Amendments did not raise new issues that would require further considerations and/or search, because the Proposed Amendments simply added already searched allowable subject matter to claims 1 and 12. Thus, if the Proposed Amendments had been entered in the Advisory Action dated October 3, 2007, the application would have been placed in condition for allowance.

Finality of the Office Action dated April 12, 2007

As a basis for the finality of the Office Action dated April 12, 2007, the Examiner asserted that the new ground(s) of rejection presented in that Office Action were necessitated by Applicants' amendment. Applicants respectfully disagreed because the amendments to claims 1 and 12 did not change the scope of the originally examined subject matter. Furthermore, the amendments to allowable claim 24, simply placed the claim in better form. See Amendment and Reply under 37 C.F.R. § 1.116 filed September 12, 2007. Further, Applicants noted that according to MPEP § 706.07, if an Examiner is not using a new ground of rejection, a final rejection should include a rebuttal of any arguments raised in the Applicants' reply. See *Id.* The

Applicants also noted that the Office Action dated April 12, 2007 did not provide a rebuttal. See *Id.*

If the Examiner would have withdrawn the Finality of the Office Action according to the Applicants Remarks in Amendment and Reply under 37 C.F.R. § 1.116 filed September 12, 2007, Applicants could have entered Proposed Amendment and placed the Application in condition for Allowance, before the Prosecution on the merits was closed.

Interview of October 10, 2007

In the Examiner interview of October 10, 2007 the Examiner indicated that the entry of Proposed Amendments would place rejected claims 1-8, 10-18 and 20-23 in condition for allowance. See Statement of Substance of Examiner Interview October 10, 2007. The Examiner indicated that his SPE determined a Notice of Allowance should not be issued by the Examiner based on the fact that the Finality of the Office Action dated April 12, 2007 was proper. See *Id.* Regardless of the appropriateness of the Finality of the Office Action dated April 12, 2007, entry of the Proposed Amendments would have, as indicated by the Examiner, placed the rejected claims in condition for allowance. By not allowing the Examiner to issue a Notice of Allowance before the SPE unnecessarily prolonged the prosecution of this application.

Conclusion

Applicants respectfully request that the Panel reopen prosecution and issue a Notice of Allowance for the claims presented in the Sept. 12th Amendment. This approach will provide the most cost-effective resolution of the prosecution of the this matter. Upon receipt of a Notice of Allowance, Applicants will withdraw their Appeal and Petition.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency,
or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Michael D. Specht", written in a cursive style.

Michael D. Specht
Attorney for Applicants
Registration No. 54,463

Date: October 12, 2007

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

732752_1.DOC